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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,362	04/23/2001	Kazuma Tomizuka	081356/0158	4670

7590

10/06/2006

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EXAMINER

TON, THAIAN N

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/763,362

Applicant(s)

TOMIZUKA ET AL.

Examiner

Thaian N. Ton

Art Unit

1632

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: NONE.
Claim(s) objected to: NONE.
Claim(s) rejected: 93,96-112,117-124,126,135 and 138.
Claim(s) withdrawn from consideration: 26-83 and 85.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER


11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). 9/14/06
13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because:

The prior rejection of claims 93, 96-112, 117-124, 126, 135, 136, 138 stand rejected for reasons of record, advanced in the prior Office action, mailed 5/15/06.

Applicants argue that they have now deleted the term "entire" from claims 100, 103, 105 and 110, and thus, all of the pending claims are now allowable. Applicants argue that any person of skill in the art would know the location (locus) of antibody genes on human chromosomes. Applicants provide Collins et al. for guidance to show the location of genetic markers on human chromosome 2, and show that HCF2 is described and LIF, and that the antibody genes, IGL, are located between these two markers. Applicants provide Kuriowa to show the location of the human antibody lambda light chain genes and associated gene markers, as well as Weichhold et al. to produce the location of the human antibody kappa light chain. Applicants argue that these pieces of art provide sufficient guidance for the locus of the various genes that are encompassed by the claims.

These arguments are fully considered, but are not persuasive. Although one of skill might know the location of the various Igs, the location of these immunoglobulins is relative to other genetic markers. The claims still encompass entire gene loci, as well as fragments of gene loci of any antibody gene. It is maintained that determination of genes that are closely linked could clearly identify various fragments of an antibody gene locus, but the entire locus can encompass upstream, downstream and non-coding sequences of the locus, which the specification has neither described nor provided for. Furthermore, it is clear that although Applicants' have provided guidance for specific immunoglobulin genes, the breadth of "any antibody gene locus" is not enabled, because the specification has not provided guidance with for example, the breadth of entire gene loci of various antibodies encompassed by the claims. These arguments are also set forth in the prior Office action, pages 4-5, mailed 5-15-05. Accordingly, the prior rejection of record is maintained.



RAM R. SHUKLA, PH.D.
SUPERVISORY PATENT EXAMINER